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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,377	08/22/2003	Walter Hehl	CH920010016US1	9975
7590 Derek S. Jennings Intellectual Property Law Dept. IBM Corporation P.O. Box 218 Yorktown Heights, NY 10598			EXAMINER NELSON, FREDA ANN	
			ART UNIT 3628	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			03/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/646,377	Applicant(s) HEHL ET AL.	
	Examiner Freda A. Nelson	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 13-19 is/are rejected.
- 7) ☒ Claim(s) 6-12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The amendment received on December 20, 2006 is acknowledged and entered. Claims 1-19 have been amended. No claims have been added. Claims 1-19 are currently pending.

Response to Amendment and Arguments

Applicant's arguments filed December 20, 2006 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the sender of email and the sending party both belong to the same group [see page 12]) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's arguments that it is highly unlikely that these fans and stars all belong to the same email group, the examiner respectfully disagrees. Jensen teaches a "Receiver party" or "Star" is any person, group, organization, or entity whom another person would know, recognize, identify, or address a communication to. "Fan", Caller party, or "Member of the General Public" is any person who knows, recognizes, or addresses a communication to a person, group, organization, or entity. The term "know" or "known" should be defined broadly and include recognition, identification, association, or publication with, to, or by another. A

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"network" is any means, mechanism, or process to connect, join, transfer Information, recognize, or otherwise link two or more devices, sites, locations, persons, or entities such that information or content in whatever form may be transferred or passed from one device, site, location, person, or entity to another device, site, location, person, or entity (paragraph [0048]). Jensen further teaches that the system and method is not limited to "e-mail" and has application to all areas of communication or transmission including voice, video, audio, interactive television, auctions, radio, telecommunications, paging, wireless communications, the internet, internet chat, two-way cable service, broadcasting, and satellite communications (paragraph [0067]).

In response to applicant's argument that there is no suggestion to combine the Jensen and Tanigawa, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation of passing on accumulated points to the user as money is found in Tanigawa (paragraph [0011]).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 17, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1-4, 13-15, and 18-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Jensen (US PG Pub. 2002/0107697).**

As per claims 1 and 18-19, Jensen discloses a method for dynamically allocating a cost to an e-mail, the method comprising the steps of:

forwarding by a first user, who is a member of an email group, said e-mail to a market engine for allocating a cost to said e-mail (paragraph [0052]);

determining by said market engine the cost of said e-mail based upon intrinsic and extrinsic criteria (paragraph [0053],[0177]);

submitting the cost of said e-mail to said first user for agreement by said first user (paragraph [0189]);

forwarding by said market engine said e-mail to a second user in response to said agreement by the first user, wherein the said second user is a member of the email group (paragraphs [0048],[0067],[0054]; [0189]); and

updating a credit account associated with said first user (paragraph [0048],0062],[0183]).

As per claim 2, Jensen discloses the method according to claim 1, further comprising the step of running said market engine as a local market engine when running at a client device associated with each user (paragraph [0120],[0124],[0128]).

As per claim 3, Jensen discloses the method according to claim 1, further comprising the step of running said market engine as a central market engine including a user credit database which contains the credit accounts of all users and which is accessed by said central market engine when said market engine has to determine the cost of said e-mail (paragraph [0048])

As per claim 4, Jensen discloses the method according to claim 3, further comprising the step of maintaining the credit account of each user in a credit database at a client device associated with said user (paragraph 0048)].

As per claim 13, Jensen discloses the method according to claim 1, further comprising the step of re-prioritizing and repositioning said e-mail by said second user when it is received from said market engine (paragraph [0206]).

As per claim 14, Jensen discloses the method according to claim 1, further comprising the step of providing said group as a large company and said users as employees of said company (paragraph [0210]).

As per claim 15, Jensen discloses the method according to claim 1, further comprising the step of providing said market engine as a central market engine when running as a server (FIG. 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen (US PG Pub. 2002/0107697) in view of Tanigawa (US PG Pub. 2003/0074255).

As per claim 5, Jensen does not expressly disclose the method according to claim 4 wherein said step of maintaining said credit account included in the credit database of said central market engine and the credit database at the client device associated with each user further includes the step of providing for said user a number of credit points at some specific periods.

However, Tanigawa discloses that a point is added to a user member in accordance with the contents of the action of the member such as reception of an electronic mail from the mail delivery terminal 6 or transmission of a reply to a received electronic mail, and point information for each member is stored in the member registered information database 4 (abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Jensen to include the feature of Tanigawa in order to increase users by awarding points to be passed on as money (Tanigawa; paragraph [0011]).

4. The following is an examiner's statement of reasons for allowance:

A) the prior art for example:

(1) Jensen (US PG Pub. 2002/0107697), discloses a method and system to enable, to organize, to facilitate, and to transact communications for a fee or cost utilizing a network such as the Internet.

(2) Tanigawa (US PG Pub. 2003/0074255), which discloses a method of transmitting and receiving information using electronic mail.

However, in regard to claims 6-12 the prior art does not teach or suggest specific manner in which the e-mail is dynamically priced as recited in these claims.

5. Claims 6-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. As allowable subject matter has been indicated, applicant's response must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 C.F.R. § 1.111(b) and section 707.07(a) of the M.P.E.P.

6. Claim 17 is objected to as being dependent upon a rejected base claim would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Freda A. Nelson whose telephone number is (571) 272-7076. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

FAN 3/03/2007


JOHN W. HAYES
SUPERVISORY PATENT EXAMINER